

## REMARKS

Claims 1-31 remain pending in the present application. Claims 1-31 are rejected. Claim 23 has been amended herein. No new matter has been added.

### 1.105 Request for Information

The Office Action requests identification by page number and column lines the portion of the Specification that defines a “bad boy list”.

Support can be found in the Specification including at least page 88 lines 1-4 and Figure 9, page 131 line 24 through page 132 line 6, and Figure 17. Further support can be found at least at page 141 line 15 through page 142 line 15 and Figure 20; page 142 line 16 through page 143 line 8, page 143 line 10 through page 144 line 15. A few examples of bad boy list programs would include audio hijack, wiretap, Nero, Roxio, Exact Audio Copy, etc.

### Claim Rejections - 35 U.S.C. §112

The present office action states that Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the presence of “Macintosh Operating System” is not proper.

Applicants respectfully submit section 2173.05(u) of the MPEP states, “The presence of a trademark or trade name in a claim **is not**, per se, improper under 35 U.S.C. 112, second paragraph” (emphasis added).

Thus, Applicants submit the utilization of a reference to MPEP 2173.05(u) in the present Office Action does not constitute a proper rejection. That is, since MPEP 2173.05(u) clearly provides that the presence of a trademark or trade name in a claim **is not, per se, improper** under 35 U.S.C. § 112, second paragraph, Applicants respectfully

submit the prima facie case for a rejection under 35 U.S.C. § 112, second paragraph, has not been met.

Additionally, at least at page 18 lines 1-4 ( similarly at page 7, 11 and 14), the present Office Action mailed 12/23/2008 states, “At the time of invention, Windows operating systems, Mac operating systems and Linux operating systems were the predominant types of Operating systems.” (Emphasis Added). Thus, Applicants respectfully submit the Office Action clearly supports the Applicants argument that Macintosh operating system or MAC O/S has a fixed and definite meaning. Further, there appears to be no other term known to the Applicants, or utilized by the Office Action, which will provide as sufficient an identification of the operating system characteristics as the term “Macintosh Operating System”.

Moreover, Applicants respectfully submit that the USPTO has a well established precedence for utilization of the term “Macintosh”. For example, a quick search of the USPTO database resulted in more than 50 issued patents; and more than 60 patent applications that include the term “Macintosh” including, for example, 5,386,493; 6,023,558; 7,089,300; 5,621,906; 7,130,888; 6,298,446; 20070005663; 20020035612, etc.. Thus, with reference to this well-established precedence, Applicants respectfully submit the Macintosh operating system has clearly been proven as a fixed and definite description.

For these reasons, Applicants respectfully submit the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the presence of the trademark “Macintosh Operating System” is improper and should be withdrawn as Macintosh operating system or MAC O/S has a fixed and definite meaning and there is no other term known to the Applicants which will provide as sufficient identification of the operating system characteristics as the term “Macintosh Operating System”.

#### Claim Rejections - 35 U.S.C. §101

##### Claims 23-31

Claims 23-31 are rejected under 35 U.S.C. §101, because claimed invention is directed to a non-statutory subject matter.

Applicants have amended Claim 23 to include a statutory element. Therefore, Applicants respectfully submit the rejection under 35 U.S.C. §101 with respect to Claims 23-31 is moot.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-3, 6-7, and 9-11

Claims 1-3, 6-7, and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty et al. (US 6,920,567), hereinafter “Doherty”. Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-3, 6-7, and 9-11 are not anticipated by Doherty for the following reasons.

Applicants respectfully submit that Independent Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism providing stand alone functionality and operation on said client system, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of** said compliance mechanism is invalidated” (emphasis added).

Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Applicants respectfully understand Doherty et al. to teach away from the claimed features. For example, at least at column 3 lines 36-45, Applicants respectfully understand Doherty et al. to teach disadvantages including, “relying upon mechanisms that are separate and independent from a licensed program, rather than a means that is related to the program itself, thereby providing only limited protection and being readily vulnerable to various methods for bypassing such forms of protection.” (Emphasis added)

In addition, at least at column 3 lines 46-53, Applicants respectfully understand Doherty et al. to teach away from methods and systems that limit the types of systems in which the programs and licensing enforcement mechanisms may be employed, and the means by which the licensed programs and licenses may be distributed.

For these reasons, Applicants respectfully submit that Claims 1-3, 6-7, and 9-11 are not taught or rendered obvious over Doherty, and as such, the rejection under 35 U.S.C. §103(a) is overcome and Claims 1, 12 and 23 are allowable. Also, since Claims 2-3, 6-7 and 9-11 depend from Independent Claims 1, 12, and 23, Applicants respectfully submit Claims 2-3, 6-7 and 9-11 derive patentability at least therefrom.

#### Claims 4, 5, 8 and 12-31

Claims 4, 5, 8 and 12-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty in view of Schreiber et al. (US 6,298,446), hereinafter “Schreiber”. With respect to Claims 4, 5, 8 and 12-31, Applicants respectfully assert that Doherty and Schreiber, alone or in combination, fail to teach or suggest the claimed subject matter.

Applicants respectfully submit that Independent Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism providing stand alone functionality and operation on said client system, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of said compliance mechanism is invalidated**” (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Doherty teaches away from the features of Claims 1, 12 and 23.

Moreover, the combination of Schreiber does not overcome the shortcomings of Doherty. That is, Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicants respectfully submit that there is no motivation to combine the teachings of Doherty and Schreiber, because Doherty teaches away from the suggested modification.

That is, Applicants do not understand As such, Applicants respectfully submit that Doherty alone or in combination with Schreiber fails to teach or render obvious the features of Claims 1, 12 and 23. As such, Applicants respectfully submit Claims 1, 12 and 23 are allowable.

With respect to Claims 4, 5 and 8, Applicants respectfully submit that Claims 4, 5 and 8 depend from the allowable Claim 1 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 4, 5 and 8 are allowable as pending from an allowable base Claim.

With respect to Claims 12-22 Applicants respectfully submit that Claims 13-22 depend from the allowable Claim 12 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 13-22 are allowable as pending from an allowable base Claim.

With respect to Claims 23-31 Applicants respectfully submit that Claims 24-31 depend from the allowable Claim 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 24-31 are allowable as pending from an allowable base Claim.

#### Claims 1-7 and 19-31

Claims 1-7 and 19-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty in view of Pastorelli (US 2004/0133801), hereinafter “Pastorelli”. With respect to Claims 1-7 and 19-31, Applicants respectfully assert that Doherty and Pastorelli, alone or in combination, fail to teach or suggest the claimed subject matter.

Applicants respectfully submit that Independent Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism providing stand alone

functionality and operation on said client system, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and  
a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and  
preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of** said compliance mechanism is invalidated” (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Doherty teaches away from the features of Claims 1, 12 and 23.

Moreover, the combination of Pastorelli does not overcome the shortcomings of Doherty. That is, Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicants respectfully submit that there is no motivation to combine the teachings of Doherty and Pastorelli, because Doherty teaches away from the suggested modification.

That is, Applicants do not understand As such, Applicants respectfully submit that Doherty alone or in combination with Pastorelli fails to teach or render obvious the features of Claims 1, 12 and 23. As such, Applicants respectfully submit Claims 1, 12 and 23 are allowable.

With respect to Claims 23-31, Applicants respectfully submit that Claims 24-31 depend from the allowable Claim 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 24-31 are allowable as pending from an allowable base Claim.

With respect to Claims 1-7, and 9-11 Applicants respectfully submit that Claims 2-7 and 9-11 depend from the allowable Claim 1 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-7 and 9-11 are allowable as pending from an allowable base Claim.

With respect to Claims 2-22 Applicants respectfully submit that Claims 2-11 and 13-22 depend from the allowable Claims 1 and 12 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-11 and 13-22 are allowable as pending from an allowable base Claim.



### CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-31 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,  
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Date: March 23, 2009

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